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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/710,777	08/02/2004	Thomas Michael Steffl	717228.11	4776
27128	7590	03/02/2006		
BLACKWELL SANDERS PEPER MARTIN LLP 720 OLIVE STREET SUITE 2400 ST. LOUIS, MO 63101			EXAMINER TRUONG, THANH K	
			ART UNIT	PAPER NUMBER
			3721	

DATE MAILED: 03/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/710,777	Applicant(s) STEFFL ET AL.	
	Examiner Thanh K. Truong	Art Unit 3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 16-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-10 and 15 is/are rejected.
- 7) ☒ Claim(s) 5 and 11-14 is/are objected to.
- 8) ☒ Claim(s) 1-24 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 August 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-15, drawn to an apparatus for inserting a data storage device into a carrier, classified in class 53, subclass 254.
  - II. Claims 16-24, drawn to a method for loading a plurality of data storage devices into a carrier, classified in class 53, subclass 473.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process as claimed can be practiced by another and materially different apparatus such as the one that does not have a conveyor system and a filling station or the process as claimed can be practiced by hand.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

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2. During a telephone conversation with Mr. Robert Lewis on February 3, 2006 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-15. Affirmation of this election must be made by applicant in replying to this Office action. Claims 16-24 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Claim Objections***

4. Claims 5 and 11-13 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim --should refer to other claims in the alternative only--, and/or, --cannot depend from any other multiple dependent claim--. See MPEP § 608.01(n). Accordingly, the claims 5 and 11-13 have not been further treated on the merits.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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6. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "into a second recess of a carrier" (lines 3-4) is vague and indefinite, because it is unclear that is the Applicant referred to the second recess of the same carrier or the second recess of another carrier. Furthermore, there is no limitation set forth in any claims (1-9) that a carrier has more than one recesses.

### ***Drawings***

If in claim 10 the Applicant claimed that a second recess of the same carrier is filled with a second data storage device, the drawing to show the feature (the depositing of the second data storage device in the second recess) also requires.

7. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the filling of the second data storage device in the second recess of the same carrier must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet,

and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-4, 6-10 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Proffitt et al. (5,844,593).

Proffitt et al. discloses an comprising:

a conveyor system having a first conveyor (32) with a feed end (33) portion and a discharge end (34) portion and adapted to convey a data storage device carrier (X) in a direction from the feed end portion to the discharge end portion (Fig. 1);

a first filling station (40) having a device for placing a data storage device (Y) adjacent to the carrier associated with the conveyor (Figs. 1 & 6E); and

a guide structure (145, 146) positioned adjacent the conveyor forming a groove for receipt of a portion of the carrier therein and forming an opening into a lower portion of a recess in a carrier opening being adapted to allow a portion of the data storage device to move into the recess through the opening (Figs. 6A, 6B & 6E – the examiner construes that the carrier (X) is positioned inside the guide structure (145, 146) and the guide structure forms an opening on the carrier, and the opening is adapted to receive the data storage device).

Proffitt et al. further discloses:

the apparatus being operable to position the carrier at a first angle of at least about 25 degrees (as in claim 2), at least about 35 degrees (as in claim 3), and in the range of between about 35 degrees and about 60 degrees (as in claim 4) from horizontal at the filling station (Fig. 6E shows that the carrier is at an angle of about 90 degrees);

wherein the first conveyor including a first conveyor belt (70) adapted to move carriers in a direction from the feed end portion toward the discharge end portion, said first conveyor belt having an exposed first surface portion for engaging the carriers (X) and wherein the conveyor system including a second conveyor belt (70) having a second surface portion facing and spaced from a portion of the first surface portion forming a portion of the guide structure and the groove (Figs 4, 6, 6A, 6B & 6E) (as in claims 6 & 15);

wherein the apparatus (Fig. 5) including a power drive (90) associated with the first and second conveyor belts and operable to effect movement of the first and second conveyor belts at the filling station at substantially the same speeds (as in claim 7);

wherein the apparatus including a securement station operable to effect engagement between the data storage device and the respective carrier (Figs. 1 & 7 show that after the data storage device is deposit into the carrier, the carrier walls are closed and the apparatus creates the effect of engagement between the data storage device and the respective carrier (as in claim 8);

wherein the securment station including a grooved roller (130) arrangement rotatably mounted to the apparatus (as in claim 9); and

Figures 1 & 7 show that a second recess of a second carrier also is filled a second data storage device at the second filling station spaced (next to each other) from the first filling station (as in claim 10).

10. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Cronauer (5,709,069).

Cronauer discloses an comprising:

a conveyor system having a first conveyor (30) with a feed end portion (where the carrier is fed in to the conveyor system – Figs.1 & 2 and column 3, lines 34-35 & 51-53) and a discharge end portion (after the carrier is filled with the data storage device – Fig. 2) and adapted to convey a data storage device carrier (34) in a direction from the feed end portion to the discharge end portion (Fig. 2);



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a first filling station (18) having a device for placing a data storage device (60) adjacent to the carrier associated with the conveyor (Figs. 2); and

a guide structure (52) positioned adjacent the conveyor forming a groove for receipt of a portion of the carrier therein and forming an opening into a lower portion of a recess in a carrier opening being adapted to allow a portion of the data storage device to move into the recess through the opening (Fig. 2).

Cronauer further discloses:

the apparatus being operable to position the carrier at a first angle of at least about 25 degrees (as in claim 2), at least about 35 degrees (as in claim 3), and in the range of between about 35 degrees and about 60 degrees (as in claim 4) from horizontal at the filling station (Fig. 2 shows that the carrier is at an angle of about 90 degrees).

### ***Allowable Subject Matter***

11. Claim 14 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

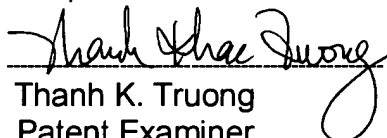
12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanh K. Truong whose telephone number is 571-272-4472. The examiner can normally be reached on Mon-Thru 8:00AM - 6:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Thanh K. Truong  
Patent Examiner  
February 25, 2006.